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JUL 01 2009

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(Assignee)

CENTRAL REEXAMINATION UNIT

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(First Named Inventor)

In re Application of :  
William R. Sprague et al. : DECISION  
Application No. 09/458,132 : TERMINATING  
Filed: December 9, 1999 : REISSUE PROCEEDING  
Practitioner Docket No.: SPRAGUE-REI-1 :  
:

This is a decision terminating the instant reissue proceeding by default based on: (1) the expiration of U.S. patent 5,842,629, for which patent the present application requests reissue, and (2) the failure of applicants to respond (a) to the Order to Show Cause mailed by the Office to the correspondence address of record on March 10, 2009, and (b) the Show Cause Order & Letter Forwarding Returned Order To Show Cause mailed by the Office to the first named inventor and the assignee of record on April 23, 2009.

## BACKGROUND

1. Reissue application No. 09/458,132 ("the '132 reissue application") was filed on December 9, 1999, for reissue of U.S. Patent No. 5,842,629 ("the '629 patent") issued December 1, 1998.
2. The Image File Wrapper record for the '132 reissue application reveals that a decision granting a petition to withdraw holding of abandonment was issued on January 5, 2005.
3. The Office's financial records reveal that the 7.5 year maintenance fee due by December 1, 2006 (the end of the maintenance fee grace period), was not paid.

4. The '629 patent expired at midnight on December 1, 2006, for failure to pay the 7.5 year maintenance fee that was due.<sup>1</sup> Notice of the expiration of the '629 patent for failure to pay the 7.5 year maintenance fee was published on January 30, 2007, in the *Official Gazette*.<sup>2</sup>
5. On March 10, 2009, an Order to Show Cause was mailed to applicants, setting a 30-day period for a response showing sufficient cause why the Office should not terminate the present reissue proceeding. The Order clearly provides that a failure by applicants to respond to the show cause order within the set 30-day period will result in the termination of the present reissue proceeding by default.
6. On April 23, 2009, a Show Cause Order & Letter Forwarding Returned Order To Show Cause was mailed to the first named inventor and to the assignee of record of the '629 patent, in accordance with MPEP 707.13. The April 23, 2009 Letter reset the time period for reply to the March 10, 2009 Order to expire 30 days from April 23, 2009.
7. No response to the March 10, 2009 Order to Show Cause or the April 23, 2009 Letter has been received by the Office, and the 30-day period for response to the Letter has expired.

## DECISION

As pointed out above, no response to the March 10, 2009 Order to Show Cause or the April 23, 2009 Letter has been received by the Office, and the 30-day period for response to the Letter has expired. In addition, there is no record of any filed petition addressing the failure to pay the 7.5 year maintenance fee, as would be required in order to reinstate the '629 patent.

When a patent has expired, the Director of the USPTO no longer has the authority under 35 U.S.C. 251 to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993). As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only 'for the unexpired part of the term of the original patent.' Thus, when Morgan's original patent expired on August 19, 1992, the Commissioner was divested of his reissue authority because there no longer was an unexpired term of the patent for which Morgan's patent could be reissued. Morgan's appeal thus became moot." [990 F.2d at 1231, 26 USPQ2d at 1393][Emphasis added.]

Since the '629 patent expired for failure to pay the requisite maintenance fee, and applicants have not provided any information to the contrary after being afforded an opportunity to do so, the instant reissue application is hereby terminated. Accordingly,

<sup>1</sup> See: MPEP § 2506, third paragraph.

<sup>2</sup> See: <http://www.uspto.gov/web/offices/com/sol/og/2007/week05/patexpi.htm>.

the Technology Center is to proceed to hold the reissue application to be an abandoned application, and process the application accordingly.

### CONCLUSION

1. The present reissue application is hereby terminated.
2. Jurisdiction over the reissue application file is being forwarded to Technology Center Art Unit 3689 for processing the application as an abandoned application.
3. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.



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Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

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